

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/581,261

**Applicant(s)**

KORNFALT ET AL.

**Examiner**

Brent T. O'Hern

**Art Unit**

1794

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): all 35 USC 112 rejections.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-11 and 13-20.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: PTO/892, copy of WO 03/060256.

/BTO/  
Brent T. O'Hern  
Examiner, Art Unit: 1794

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794

Continuation of 11, does NOT place the application in condition for allowance because:

As an initial matter, most of Applicant's arguments are not commensurate in scope with the claims as Applicant appears to be arguing the claims have a narrower scope than set forth in the claims.

As can be seen in independent claim 1, the claims just require two panels in the system to be different from each other and for the decorative material to contain materials from the listed group of materials. The text of the claims do not specify how the panels are different but rather that they are different which is always the case with two different panels as they are at least physically different from each other. The materials of construction language are different limitations.

In response to Applicant's request of a translation of Grau ('256) it is noted Grau ('181) is interpreted as the English language equivalent to Grau ('256). The Examiner has included a translation of Grau ('256) which appears to be equivalent to Grau ('181).

In response to Applicant's arguments (See p. 7, para. 2 to p. 9, para. 1 of Applicant's Paper filed 7-8-2009.) that Grau ('256) does not teach claims 1+ because Grau ('256) does not teach two panels having surfaces made from different classes of material, it is noted as discussed above that the claims do not set forth such limitations. If Applicant intends for the surface materials of the panels to each be made from different materials then Applicant is advised to consider setting forth such limitations. Applicant's arguments are not commensurate in scope with the claims. Furthermore, as illustrated in at least FIG-2, the surface materials of abutting panels are made from different materials.

In response to Applicant's arguments (See p. 9, para. 2 to p. 10, para. 1 of Applicant's Paper filed 7-8-2009.) that Hansson ('046) does not teach claims 1+ because Hansson ('046) does not teach two panels having surfaces made from different classes of material, it is noted as discussed above that the claims do not set forth such limitations. If Applicant intends for the surface materials of the panels to each be made from different materials then Applicant is advised to consider setting forth such limitations. Applicant's arguments are not commensurate in scope with the claims. Furthermore, as made of record Hansson ('046) teaches the panels covered with a map with each piece of the map including a different piece of the map, thus each panel has a different decoration.

In response to Applicant's arguments (See p. 10, paras. 2-4 of Applicant's Paper filed 7-8-2009.) that Sjoberg ('812) does not teach claims 1+ because Sjoberg ('812) does not teach two panels having surfaces made from different classes of material, it is noted as discussed above that the claims do not set forth such limitations. If Applicant intends for the surface materials of the panels to each be made from different materials then Applicant is advised to consider setting forth such limitations. Applicant's arguments are not commensurate in scope with the claims.

In response to Applicant's arguments (See p. 10, para. 5 to p. 11, para. 1 of Applicant's Paper filed 7-8-2009.) that Martensson ('547) and Sjoberg ('812) do not teach claims 1+ because said references do not teach two panels having surfaces made from different classes of material, it is noted as discussed above that the claims do not set forth such limitations. If Applicant intends for the surface materials of the panels to each be made from different materials then Applicant is advised to consider setting forth such limitations. Applicant's arguments are not commensurate in scope with the claims.

In response to Applicant's arguments (See p. 7, para. 2 to p. 9, para. 1 of Applicant's Paper filed 7-8-2009.) that Grau ('256) and Hansson ('046) do not teach claims 4-9 and 11 because said references do not teach two panels having surfaces made from different classes of material, it is noted as discussed above that the claims do not set forth such limitations. If Applicant intends for the surface materials of the panels to each be made from different materials then Applicant is advised to consider setting forth such limitations. Applicant's arguments are not commensurate in scope with the claims.

In response to Applicant's arguments (See p. 11, para. 3 to p. 13, para. 1 of Applicant's Paper filed 7-8-2009.) that Grau ('256) and Sjoberg ('812) do not teach claims 14 and 15 because there is no reason to combine said references because Grau ('256) does not teach an elastomer foil that comprises a thermoplastic elastomer and Sjoberg's ('812) foil is not on decorative surface, it is noted as discussed above that Grau ('256) teaches the surfaces made of many different materials and Sjoberg ('812) teaches panels made of thermoplastic elastomers that are resistant to abrasion, chemicals and sound (See p. 2, ll. 15-22.). The sound and chemical resistant properties are important throughout the panel.

Thus, there is reason to combine the references as made of record.

In response to Applicant's arguments (See p. 13, paras. 3-6 of Applicant's Paper filed 7-8-2009.) that since Bettinger ('237) does not teach the joining means per claim 1 it can not be taught the carpet limitations per claim 17, it is noted that Bettinger ('237) is not cited for teaching the joining means. Furthermore, the joining means in claim 1 is very broad and generic..

/BTO/  
Brent T. O'Hern  
Examiner, Art Unit: 1794